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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,893	08/09/2000	Suguru Tokita	ZU-392	5309

7590 12/18/2002

Sherman & Shalloway  
413 North Washington Street  
Alexandria, VA 22314

EXAMINER

GALLAGHER, JOHN J

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/18/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-9

# Office Action Summary

Application No.

09/601893

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 10 SEPTEMBER 2002
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-14 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-14 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
  - ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Claim 11 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Specifically, lines 15-18 of this claim as (now/once) amended (viz. "and . . . . monomer,") are seen to not meld or fit well with the remainder of this claim, thus rendering the claim vague and/or indefinite and/or confusing and/or unclear. The following changes are suggested to remedy this situation: (a) Delete the foregoing, aforementioned parenthetical (or parenthesized) term; (b) insert "and" after the term "dl/g" in line 13; and (c) insert the term "0.1 to 15% by weight of" after "a" in line 3 of this claim. Also, in claim 7, it is felt that (similarly to (b), above) the word "and" should be deleted from line 13 and inserted instead after the term "dl/g" in line 11.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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3. Claims 1-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Blunt in view of either Roberts et al. or Tomita et al.

4. Applicants' arguments filed 10 September 2002 have been fully considered but they are not deemed to be persuasive. The foregoing art rejection is adhered to essentially for the reason (i.e. LINE OF REASONING" of record (see paragraph 3 of the last Office action), with the following being additionally advanced with respect to applicants' comments, contentions and arguments as set forth in the amendment at page 4 line 9 thru page 8 line 4: (A) Blunt is seen to fairly and clearly provide for an ethylene-higher (i.e. equal to or greater than 6C) olefin copolymer (1) wherein the higher olefins are clearly disclosed (N.B. column 2 lines 3-19 (and especially lines 13-16) AND column 3 lines 43-51 (and especially lines 43-44 and 47)) i.e. this reference is NOT limited to the use of propylene and butene as the (second) monomer copolymerized with ethylene; further along this line (and the foregoing notwithstanding), note that (a) a reference disclosure is not limited to its specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested thereby to one of ordinary skill in the art (In re Uhlig 153 USPQ 460); and (b) ALL of the disclosures in a reference must be evaluated for what they fairly teach one of ordinary skill in the relevant art (i.e. obviousness

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may exist) even though the teachings relied upon may be disclosed in the art as being non-preferred (or even unsatisfactory) for the desired purpose (In re Boe 148 USPQ 507); (2) which exhibits a crystallinity of NO MORE THAN 90% (N.B. column 1 line 16, column 2 line 29 and especially column 3 lines 3-10 (and especially lines 3-6)); and (3) containing a molar percentage of higher olefin (i.e. second or co-monomer) LESS THAN ABOUT 25 or 13 m/o (depending upon the type of copolymer - N.B. column 3 line 71 thru column 4 line 4 and especially column 4 lines 1-4), such that all of the polymer properties and characteristics envisioned and claimed are seen to be documented and satisfied; while (B) Roberts et al. and Tomita et al. are (again) seen to fairly and clearly disclose that it is known to improve (i.e. render SUPERIOR, in the manner envisioned by applicants) the properties (e.g. adhesiveness etc.) of olefin copolymers of the type documented in Blunt via the functionalization thereof i.e. by the incorporation (e.g. by grafting) of a polar monomer into the (preformed) copolymer, which foregoing documented (and EXPECTED) beneficial function and result are seen to (1) constitute evidence of the obviousness of the (or a) claimed invention (In re Skoner 186 USPQ 80); and (2) provide both (more than) sufficient (a) motivation or suggestion to those of ordinary skill in this art to make the reference combination and art rejection proposed by the Examiner (as set forth in In re Fielder

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et al. 176 USPQ 300); and (b) basis for the required reasonable expectation of success (as set forth in In re Clinton 188 USPQ 365); further, each of these respective patentees are seen to fairly indicate the amount or extent of modification required (and as claimed by applicants) to reflect the aforementioned improved adhesion property viz. N.B. column 1 line 66 thru column 2 line 4 (and especially column 2 lines 2-4), column 2 lines 11-14 and column 4 lines 51-55 of Roberts et al. and N.B. column 9 lines 40-46 of Tomita et al.; and (c) with the foregoing art rejection, it is the sum total of the teachings of the applied, combined references taken as a whole which is seen to render applicants' invention obvious to one of ordinary skill in this art (In re McLaughlin 170 USPQ 209), and therefore applicants' piecemeal attack of the references individually cannot establish unobviousness, since this rejection is based upon a combination of references (In re Mapelsden 141 USPQ 30) i.e. this rejection is not overcome by pointing out that one reference does not contain a particular teaching when the reliance for that teaching was on another reference (In re Lyons, 155 USPQ 741); further, the Examiner is well aware that the proper criterion under 35 U.S.C. § 103 is obviousness and not "obvious to try" and indeed the art rejection statement has been so worded.

5. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P.

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§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. J. Gallagher whose telephone number is (703) 308-1971. The examiner can normally be reached on M-F from approximately 8:30 A.M. to 5 P.M. The examiner can also be reached on alternate N/A.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball, can be


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reached on (703) 308-2058. The fax phone number for this Group  
is (703) <sup>872-9311</sup> ~~305-3599~~.

Any inquiry of a general nature or relating to the  
status of this application or proceeding should be directed to  
the Group receptionist whose telephone number is (703)  
308-0661/0662.

  
JJGallagher:cdc

December 10, 2002



JOHN J. GALLAGHER  
PRIMARY EXAMINER  
ART UNIT 131 / 733